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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/980,949	04/22/2002	Edward Yan Tao Leung	P-370.226	1691

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08/27/2004

EXAMINER

RAMPURIA, SHARAD K

ART UNIT	PAPER NUMBER
2683	10

DATE MAILED: 08/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/980,949

Applicant(s)

LEUNG ET AL.

Examiner

Sharad Rampuria

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 6-13 is/are pending in the application.
- 4a) Of the above claim(s) 5 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6-13 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 7.9.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

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DETAILED ACTION

Claim 5 is cancelled.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-3, 6 & 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Molne [US 5999811] (hereinafter Molne) in view of Brown et al. [US 6185423] (hereinafter Brown).

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1. Regarding claim 1, Molne disclose A mobile telephone arranged to automatically re-establish roaming service with a network based on an "Operator List" (Col.3; 33-55 & Col.4; 27-35), through the use of a pre-programmed Subscriber Identity Module ("SIM") card. (Col.5; 4-12 & 25-40)

Molne fails to disclose modifying the Registered Public Land Mobile Network ("RPLMN") during location update procedure. However, Brown teaches in an analogous art, that the modifying the Registered Public Land Mobile Network ("RPLMN") during location update procedure. (Col.4; 7-14 & 61-67) Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to include modifying the Registered Public Land Mobile Network ("RPLMN") during location update procedure in order to provide a method for suppression of channel scan by using the last used channel.

2. Regarding claim 2, Molne disclose A method of automatically establishing a roaming service for a mobile telephone, (Col.3; 33-55 & Col.4; 27-35) including using a pre-programmed Subscriber Identity Module ("SIM") card such that a network update procedure (Col.5; 4-12 & 25-40) is performed in the following logical order:

2. Home Public Land Mobile Network ("HPLMN"), (1; fig.3; Col.7; 47-54)

3. Public Land Mobile Networks ("PLMNs") contained in a "PLMN Selector" data field based on an "Operator List", (1; fig.3; Col.7; 47-54)

4. User-defined preferred PLMN, (Col.3; 46-51)

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Molne fails to disclose the Registered Public Land Mobile Network ("RPLMN").

However, Brown teaches in an analogous art, that 1. Registered Public Land Mobile

Network ("RPLMN"), (Col.4; 7-14 & 61-67)

5. Other PLMNs with received signal level above a predetermined strength in random order, (Col.4; 61-67 & Col.6; 10-23) and

6. All other PLMNs in order of descending signal strength. (Col.6; 23-33) Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to include the Registered Public Land Mobile Network ("RPLMN") in order to provide a method for suppression of channel scan by using the last used channel.

3. Regarding claim 3, Molne disclose A method according to Claim 2 in which the PLMN is stored in the "Operator List" reserved in a fixed but implementation-dependent memory location in the Subscriber Identity Module. (Col.3; 33-51)

6. Regarding claim 6, Molne disclose A mobile telephone according to claim 1 wherein during location update procedure at power on of the mobile telephone a country code of the RPLMN is compared with networks defined in the "Operator List", the most preferred network with the same country code replacing the RPLMN. (Col.7; 65-Col.8; 13)

8. Regarding claim 8, Molne disclose A Subscriber Identity Module, for a mobile telephone, pre-programmed to, at power on of the mobile telephone, automatically re-establish roaming service with a network based on an "Operator List" (Col.3; 33-55 & Col.4; 27-35), wherein a country code of the RPLMN is compared with networks defined

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in the "Operator List", the most preferred network with the same country code replacing the RPLMN. (Col.7; 65-Col.8; 13)

Molne fails to disclose modifying the Registered Public Land Mobile Network ("RPLMN") during location update procedure. However, Brown teaches in an analogous art, that the modifying the Registered Public Land Mobile Network ("RPLMN") during location update procedure. (Col.4; 7-14 & 61-67) Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to include modifying the Registered Public Land Mobile Network ("RPLMN") during location update procedure in order to provide a method for suppression of channel scan by using the last used channel.

9. Regarding claim 9, Molne disclose A Subscriber Identity Module for a mobile telephone pre-programmed, to, in use, perform network update procedure (Col.5; 4-12 & 25-40) is performed in the following logical order:

2. Home Public Land Mobile Network ("HPLMN"), (1; fig.3; Col.7; 47-54)
3. Public Land Mobile Networks ("PLMNs") contained in a "PLMN Selector" data field based on an "Operator List", (1; fig.3; Col.7; 47-54)
4. User-defined preferred PLMN, (Col.3; 46-51)

Molne fails to disclose the Registered Public Land Mobile Network ("RPLMN"). However, Brown teaches in an analogous art, that 1. Registered Public Land Mobile Network ("RPLMN"), (Col.4; 7-14 & 61-67)

5. Other PLMNs with received signal level above a predetermined strength in random order, (Col.4; 61-67 & Col.6; 10-23) and

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6. All other PLMNs in order of descending signal strength. (Col.6; 23-33) Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to include the Registered Public Land Mobile Network ("RPLMN") in order to provide a method for suppression of channel scan by using the last used channel.

10. Regarding claim 10, Molne disclose A Subscriber Identity Module according to Claim 8 in which the PLMN is stored in the "Operator List" reserved in a fixed but implementation-dependent memory location in the Subscriber Identity Module. (Col.3; 33-51)

Claims 4 & 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Molne & Brown further in view of Lee et al. [US 5974328] (hereinafter Lee).

4. Regarding claim 4, the above combination discloses all the particulars of the claim except the "PLMN Selector" data comprises PLMNs listed in the "Operator List" copied on the "PLMN Selector", the "Operator List" taking precedence over User-defined preferred PLMNs which are appended at the end of the "Operator List" in the "PLMN Selector". However, Lee teaches in an analogous art, that a method according to Claim 3, in which the "PLMN Selector" data comprises PLMNs listed in the "Operator List" copied on the "PLMN Selector", the "Operator List" taking precedence over User-defined preferred PLMNs which are appended at the end of the "Operator List" in the "PLMN Selector" (Col.4; 18-33 & Col.2; 29-34). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to include the "PLMN Selector" data

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comprises PLMNs listed in the "Operator List" copied on the "PLMN Selector", the "Operator List" taking precedence over User-defined preferred PLMNs which are appended at the end of the "Operator List" in the "PLMN Selector" in order to provide rapid system access of mobile phones outside of its home service area.

11. Regarding claim 11, the above combination discloses all the particulars of the claim except the "PLMN Selector" data comprises PLMNs listed in the "Operator List" copied on the "PLMN Selector", the "Operator List" taking precedence over User-defined preferred PLMNs which are appended at the end of the "Operator List" in the "PLMN Selector". However, Lee teaches in an analogous art, that a Subscriber Identity Module according to Claim 8, in which the "PLMN Selector" data comprises PLMNs listed in the "Operator List" copied on the "PLMN Selector", the "Operator List" taking precedence over User-defined preferred PLMNs which are appended at the end of the "Operator List" in the "PLMN Selector" (Col.4; 18-33 & Col.2; 29-34). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to include the "PLMN Selector" data comprises PLMNs listed in the "Operator List" copied on the "PLMN Selector", the "Operator List" taking precedence over User-defined preferred PLMNs which are appended at the end of the "Operator List" in the "PLMN Selector" in order to provide rapid system access of mobile phones outside of its home service area.

12. Regarding claim 12, the above combination discloses all the particulars of the claim except the "PLMN Selector" data comprises PLMNs listed in the "Operator List" copied on the "PLMN Selector", the "Operator List" taking precedence over User-defined

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preferred PLMNs which are appended at the end of the "Operator List" in the "PLMN Selector". However, Lee teaches in an analogous art, that a Subscriber Identity Module according to Claim 9, in which the "PLMN Selector" data comprises PLMNs listed in the "Operator List" copied on the "PLMN Selector", the "Operator List" taking precedence over User-defined preferred PLMNs which are appended at the end of the "Operator List" in the "PLMN Selector" (Col.4; 18-33 & Col.2; 29-34). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to include the "PLMN Selector" data comprises PLMNs listed in the "Operator List" copied on the "PLMN Selector", the "Operator List" taking precedence over User-defined preferred PLMNs which are appended at the end of the "Operator List" in the "PLMN Selector" in order to provide rapid system access of mobile phones outside of its home service area.

Claims 7 & 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Molne in view of Lee.

7. Regarding claim 7, Molne disclose a method of automatically establishing a roaming service for a mobile telephone, (Col.3; 33-55 & Col.4; 27-35)

Molne fails to disclose the "PLMN Selector" data field based on the "Operator List" have precedence over User-defined preferred PLMNs which are appended at the end of the "Operator List" in the "PLMN Selector" data field based on an "Operator List" have preference over other User-defined or Operator-defined preferred PLMNs. However, Lee teaches in an analogous art, that wherein during a network update procedure PLMNs contained in the "PLMN Selector" data field based on the "Operator

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List" have precedence over User-defined preferred PLMNs which are appended at the end of the "Operator List" in the "PLMN Selector" data field based on an "Operator List" have preference over other User-defined or Operator-defined preferred PLMNs. (Col.4; 18-33 & Col.2; 29-34, Col.3; 6-26). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to include the "PLMN Selector" data field based on the "Operator List" have precedence over User-defined preferred PLMNs which are appended at the end of the "Operator List" in the "PLMN Selector" data field based on an "Operator List" have preference over other User-defined or Operator-defined preferred PLMNs in order to provide rapid system access of mobile phones outside of its home service area.

13. Regarding claim 13, Molne disclose a Subscriber Identity Module (Col.5; 4-12 & 25-40) for a mobile telephone pre-programmed to, in use, perform a network update procedure, (Col.3; 33-55 & Col.4; 27-35)

Molne fails to disclose wherein PLMNs contained in the "PLMN Selector" data field based on the "Operator List" have precedence over User-defined preferred PLMNs which are appended at the end of the "Operator List" in the "PLMN Selector" data field based on an "Operator List" have preference over other User-defined or Operator-defined preferred PLMNs. However, Lee teaches in an analogous art, that wherein PLMNs contained in the "PLMN Selector" data field based on the "Operator List" have precedence over User-defined preferred PLMNs which are appended at the end of the "Operator List" in the "PLMN Selector" data field based on an "Operator List" have preference over other User-defined or Operator-defined preferred PLMNs. (Col.4; 18-33

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& Col.2; 29-34, Col.3; 6-26). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to include wherein PLMNs contained in the "PLMN Selector" data field based on the "Operator List" have precedence over User--defined preferred PLMNs which are appended at the end of the "Operator List" in the "PLMN Selector" data field based on an "Operator List" have preference over other User-defined or Operator-defined preferred PLMNs in order to provide rapid system access of mobile phones outside of its home service area.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharad Rampuria whose telephone number is 703-308-4736. The examiner can normally be reached on Mon-Fri. (9:00-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Trost can be reached on 703-308-5318. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.

Sharad Rampuria
August 20, 2004



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